



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,102	03/31/2004	Kristin Coit	16113-769001 / GP-241-00-	5180
26192 7590 06/10/2009 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
06/10/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/814,102

Applicant(s)

COIT ET AL.

Examiner

DANIEL LASTRA

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/24/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-9, 15, 16 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, 15, 16 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 4-9, 15, 16 and 33-36 have been examined. Application 10/814,102 (ADVERTISEMENT APPROVAL) has a filing date 03/31/2004.

Response to Amendment

2. In response to Non Final Rejection filed 09/24/2008, the Applicant filed an Amendment on 03/24/2009, which amended claims 1, 4, 9, 15, 16, cancel claims 2-3, 10-14, 17-32 and added new claims 33-36.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 4-9, 15-16, 35-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to

meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus). The Applicant needs to add structure to the embodiment of the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-9, 15, 16 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman (US 2005/0021649).

Claims 1, 33 and 34, Goodman teaches:

A computer-implemented method comprising:

accepting a set of advertisements from an advertiser (see paragraph 98);

determining if the advertiser is a trusted advertiser (see paragraph 99);
submitting, in response to determining that the advertiser is a trusted advertiser, the advertisements in the set of advertisements for review using an automated review process, wherein the automated review process comprises automatically approving or disapproving advertisement based on the content of the advertisement (see paragraph 98);

in response to a determination that the advertiser is not a trusted advertiser: selecting a subset of the set of advertisements (see paragraph 110); submitting the subset of advertisements to be reviewed to a manual review process for approving or

disapproving an advertisement based on the content of the advertisement (see paragraph 110);

determining a trust score for the advertiser using information based on the manual review of the subset of advertisements (See paragraph 110); and if the trust score is less than a threshold trust score (see paragraph 98) submitting the advertisements in the set of advertisements not in the selected subset for review using the automated review process (see paragraph 48, 110-111 "system checks a subset of the potential spammer's outgoing messages by a human and because the score is less than a threshold the sender is not a spammer and therefore, all the sender messages are allowed to be sent and check automatically using filters as it is not necessary for a human to inspect them again"); if the trust score is greater than or equal to a threshold trust score (see paragraph 48): submitting the advertisements in the set of advertisements not in the selected subset to be reviewed using the manual review process and allowing approved advertisements from the set of advertisements to be served by an advertisement server (see paragraph 48, 98-101 "a high score determines a high probability that a sender is a spammer therefore, message are sent for human review in order to determine which messages are spam and which are not"); and

automatically allowing approved advertisements of the set that are not in the subset to be served if the trust score indicates that the advertiser is a trusted advertiser (see paragraph 111 "the sender is not a spammer, therefore, the score of a sender is reset and the threshold level increase in order that trusted senders are allowed to send

their messages). In Goodman when a sender's score is less than a threshold value, said sender is considered a trusted sender, however, in Applicant's claimed invention, when the sender's trust score (i.e. advertiser) is less than a threshold trust score, said sender is not considered a trusted sender or advertiser. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that said difference between Goodman and Applicant's claimed invention would not patentably distinguish the claimed invention from the prior art because Goodman teaches the concept of comparing a sender score to a threshold value in order to determine the probability of said sender being a trusted sender or not.

Claim 4, Goodman teaches:

wherein the trust score indicates a degree of distrust is a distrust score (see paragraph 48).

Claim 5, Goodman teaches:

wherein determining the trust score for the advertiser further comprises determining a percentage of declined advertisements in the subset (see paragraph 15).

Claim 6, Goodman teaches:

wherein determining the trust score further uses reasons for which declined advertisements in the subset were declined (see paragraph 110).

Claim 7, Goodman teaches:

wherein the set of advertisements comprises Web advertisements (see paragraph 110).

claim 8, Goodman teaches:

automatically screening the approved advertisements for preselected words or phrases (see paragraph 44).

Claim 9, Goodman teaches:

wherein at least one of the preselected words is a URL (see paragraph 44).

Claim 15, Goodman teaches:

A computer-implemented method of ad approval comprising: selecting a subset of a first ad group provided by a trusted advertiser (see paragraph 110); accepting a determination of advertisements in the subset that are disapproved (see paragraph 110);

determining a trust score using information concerning disapproved advertisements in the subset, approved advertisements in the subset, and reasons for any disapprovals (see paragraph 110); and

pulling from circulation at least one ad in a second ad group received from the trusted advertiser if the trust score indicates that the trusted advertiser is no longer a trusted advertiser (see paragraph 104).

Claim 16, Goodman teaches:

wherein the determination of advertisements in the subset that are disapproved is accepted from a manual review process (see paragraph 110).

Claim 35, Goodman does not teach:

wherein accepting the set of advertisements from the advertiser includes receiving advertisements from a syndication system that is configured to aggregate and collect advertisements from third parties that submit third party advertisements to the

syndication system for placement on a web page of a content publisher. However, Official Notice is taken that it is old and well known in the promotion art for central server to receive advertisements from third parties and transmit said advertisements to content providers' web sites when a user access said content providers websites. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that in Goodman, a central server would collect advertisements from third parties and would send said advertisements to be displayed in content providers as it is old and well known in the promotion art to use central servers to aggregate advertisements to be delivered to different content providers.

Claim 36, Goodman teaches:

wherein accepting the set of advertisements from the advertiser includes receiving the advertisements directly from a system of organization that produced the advertisement (see paragraph 110).

Response to Arguments

5. Applicant's arguments filed 03/24/2009 have been fully considered but they are not persuasive. The Applicant argues that the prior art does not teach Applicant's claimed invention because according to the Applicant, the prior art is not directed to placement of advertisements. The Examiner answers that Goodman teaches that the sender's message include advertisements (see paragraph 110). Therefore, contrary to Applicant's claimed invention, Goodman teaches Applicant's claimed invention.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Examiner, Art Unit 3688
June 6, 2009